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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,063	01/14/2000	Ker Sze Toh	1662-15100(P99-2434)	7851

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EXAMINER

DINH, MINH

ART UNIT PAPER NUMBER

2132

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/483,063

Applicant(s)

TOH ET AL.

Examiner

Minh Dinh

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-19 and 24-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 26-32 and 38-40 is/are rejected.
- 7) ☒ Claim(s) 33-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 06/30/2005. Claims 15, 17, 19 and 24-25 have been amended; claims 1-14 and 20-23 have been cancelled; claims 26-40 have been added.

### ***Response to Arguments***

2. Applicant's arguments, see page 9, filed 06/30/2005, with respect to the rejection(s) of claims 15 and 24 under 35 USC 103 have been fully considered and are persuasive. The rejections of claims 15 and 24 have been withdrawn.

3. Applicant's arguments with respect to claim 26 have been considered but are not persuasive. Applicant's amendments have necessitated a new search and new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-30 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (5,894,571) in view of Collie et al (6,269,377).

Regarding claims 26-27 and 38-40, O'Connor discloses a method for manufacturing a build-to-order computer system, the method comprising: obtaining, by a computer manufacturer, unique identifiers (i.e., names) for each of a plurality of software products (fig. 2, step 222); installing the plurality of software products on the computer system (fig. 2, step 230); and shipping simultaneously, by the computer manufacturer, the computer system along with a digital storage media to a customer, the digital storage media storing a backup copy of the plurality of software products (fig. 2, steps 232-234). O'Connor does not disclose writing the unique identifiers into a non-volatile memory of the computer system wherein the software products are installable by accessing the unique identifiers in the non-volatile memory. Collie discloses a software installation method in which unique identifiers of software products "advertised" for later installation are written into the install registry of a computer system. Collie also discloses that when a software product needs to be installed, its unique identifier is used to locate the corresponding software product in a source location (e.g., CD-ROM) (col. 1, lines 50-65; col. 8, lines 10-54; col. 9, lines 13-23 and 53-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Collie method into the O'Connor method such that the unique identifiers are written into a non-volatile memory of the computer system and that the software products are installable by accessing the unique identifiers in the non-volatile memory.

The motivation for doing so would have been that alternate source locations could be used.

Regarding claims 28-30, O'Connor further discloses that an order comprising the list of the software products (fig. 2, steps 216, 222) and that the software products are tested on the computer system (fig. 2, steps 216, 222, 232).

6. Claim 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Collie as applied to claim 26 above, and further in view of Day et al (6,016,400). O'Connor does not disclose storing on the digital storage media additional software products that are compatible with the computer system. Day discloses a method for installing software products to a computer system utilizing a CD-ROM on which additional software products compatible with the computer system are also stored (Abstract; col. 3, lines 31-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of O'Connor and Collie to method to store on the digital storage media additional software products that are compatible with the computer system, as taught by Day. The motivation for doing so would have been that a single CD-ROM could be used irrespective of the software configuration for a particular system.

7. Claims 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor, Collie and Day as applied to claim 31 above, and further in view of Wright et al (5,933,087). O'Connor, Collie and Day do not disclose receiving, by the computer

Art Unit: 2132

manufacturer, a request by a customer to purchase one of the additional software products after said shipping. Wright discloses a method for adding software functional options to a computer system, the method including the step of receiving, by the computer manufacturer, a request by a customer to purchase one of the additional software products after said shipping (col. 3, line 5 – col. 4, line 19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of O'Connor, Collie and Day to receive, by the computer manufacturer, a request by a customer to purchase one of the additional software products after said shipping, as taught by Day. The motivation for doing so would have been to allow adding options to the computer system.

### ***Allowable Subject Matter***

8. Claims 15 and 24 are allowable over the prior art of record.
9. Claims 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,298,443 to Colligan et al.

Art Unit: 2132

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802.

The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh  
Examiner  
Art Unit 2132

MD  
9/7/05

  
GILBERTO BARRON JR.  
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